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OFFICE OF PETITIONS

In re Application of :
Kentaro Sekiyama : DECISION ON
Application No. 10/735,853 : PETITION
Filed: December 16, 2003 :
Attorney Docket No. 061069-0307278 :

This is a decision on the "PETITION TRAVERSING NOTICE TO FILE MISSING ITEM(S) AND, IN THE ALTERNATIVE, COMPLETE RESPONSE TO NOTICE TO FILE MISSING PARTS, TWO MONTHS EXTENDED," filed August 10, 2004.

Application papers in the above-identified application were deposited on December 16, 2003. On April 28, 2004, the Office of Initial Patent Examination mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring applicant to submit the following missing items: the statutory basic filing fee; an oath or declaration; a late surcharge under § 1.16(l); an English translation of the specification and a statement that the translation is accurate; the \$130 fee under § 1.17(i); and any additional claim fees which may be due. On June 15, 2004, applicant filed a response to this Notice.

However, on July 27, 2004, the Office of Initial Patent Examination mailed a "Withdrawal of Previously Sent Notice," notifying applicant that the Notice mailed April 28, 2004 was mailed in error and was withdrawn. A corrected Notice, setting forth a new period for reply, was enclosed. The corrected "Notice of Omitted Item(s) in a Nonprovisional Application," notified applicant that a filing date had been accorded to the application; however, page 49 of the specification appeared to have been omitted. In response, applicant timely filed the instant petition.

On instant petition, applicant asserts that page 49 of the English translation of the specification was filed on June 15, 2004. Petitioner states that, in support thereof, they are submitting the Patent Office date-stamped receipt evidencing that the Office received the entire specification/claims, including page 49, on June 15, 2004. In addition, applicant provides another copy of the English translation of the specification. Applicant further states that, in the alternative, please treat the papers filed August 10, 2004 as a further response to the Notice mailed April 28, 2004 and accept this response as timely with a two-month extension of time.

The Office will accord a filing date to an application meeting the requirements of 35 U.S.C. 111(a), even though some or all of the application papers, including the written description and the claims, are in a language other than English and hence does not comply with 37 CFR 1.52. A review of the application file reveals that the application as filed, though in Japanese, was entitled to and was accorded a filing date of December 16, 2003. Further, the application as filed included "page 49" of the specification, albeit in Japanese.

However, a review of the application file further reveals that page 49 is not among the papers filed on June 15, 2004 (i.e., the English translation filed in reply to the "Notice to File Missing Parts of Nonprovisional Application"). Moreover, petitioner's evidence is not sufficient to show that the page was among the papers filed on June 15, 2004, but misplaced by the Office. The copy of the receipt presented does not bear a USPTO date-stamp. Thus, page 49 of the English translation is being treated as first submitted on August 10, 2004.

Nonetheless, the "Withdrawal of Previously Sent Notice," mailed July 27, 2004, was sent in error to the extend that it withdrew the requirements set forth in the "Notice to File Missing Parts of Nonprovisional Application," mailed April 28, 2004. A review of the application file supports a conclusion that the missing items were required. On June 15, 2004, applicant timely responded with an incomplete response. As the extendable period for reply continued to run, on the date of filing of the petition and response to Notice filed August 10, 2004 (and extension of time), the response may be accepted as timely filed on August 10, 2004.

In view thereof, the petition is GRANTED. Given the basis for granting the petition, the petition fee is being refunded to Deposit Account No. 03-3975, as authorized.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for:

- further processing with a filing date of December 16, 2003, using the application papers received in the Office on that date and the English translations thereof filed June 15, 2004; and
- processing of the response to the Notice to File Missing Parts Mailed April 28, 2004, including page 49 of the English translation, submitted on August 10, 2004.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions